

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DEC 23 2003

Ex parte JOHN SKALEN

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2004-0064
Application No. 09/787,750

ON BRIEF

Before COHEN, ABRAMS and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 6-11, which are all of the claims pending in this application. An amendment (Paper No. 10) subsequent to the final rejection was not entered (see Paper No. 12).

We AFFIRM:

BACKGROUND

The appellant's invention relates to a golf swing training apparatus. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Windall	3,122,369	Feb. 25, 1964
Deane (British patent specification)	401,955	Nov. 23, 1933

The following rejections are before us for review.

Claims 6, 7 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Deane in view of Windall.

Claims 8-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Deane in view of Windall and official notice.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 15) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 14 and 16) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims,¹ to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Appellant has elected to have all of claims 6-11 stand or fall together and has not presented separate arguments as to the patentability of claims 7-11 apart from claim 6. Therefore, claims 7-11 shall stand or fall with representative claim 6 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)).

Appellant's claim 6 is directed to a golf swing training device comprising a golf ball, a rigid² line having one end secured to the golf ball and a second end anchored in the ground, a resilient line transverse to the rigid line having both ends anchored to the

¹ It appears that "golf club" should be inserted in claim 6 after "particular."

² Consistent with appellant's underlying disclosure, we understand "rigid" to mean non-resilient or inelastic. It is quite apparent from appellant's description of the invention and the manner in which it works that the line 3 referred to in the specification and claims as "rigid" is substantially flexible. While appellant attempted to amend the term "rigid" to "non-resilient" in an amendment after final, the examiner refused to enter the amendment because it raised new issues. The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion and is not reviewable by the Board of Appeals. Rather, such an issue should be addressed by a petition under 37 CFR § 1.181 to the Commissioner, as set forth in 37 CFR § 1.127. See also In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967); In re Hengehold, 440 F.2d 1395, 1403, 169 USPQ 473, 479 (CCPA 1971). Accordingly, we shall not consider the proposed amendment in Appendix B to appellant's brief.

ground, a ring enclosing and slidable along both the rigid line and the resilient line and a plurality of marks on the rigid line, each mark indicating a reference point for the resilient line to transverse the rigid line for correct operation of the device with a particular golf club, the mark indicating a type of golf club for a player to use when the resilient line crosses the rigid line at said mark. There does not appear to be any dispute that Deane discloses the claimed invention with the exception of a plurality of marks located on the rigid line indicating a reference point for the resilient line to cross the rigid line for correct operation of the device, the mark indicating a type of golf club to be used. Deane discloses a strip of flexible material such as tape 11 which may be arranged to lie beneath the flexible inelastic cord 5 between the elastic material 8 and the stake 6. The tape is graduated and a slidably arranged bead or ball 11^a is arranged for movement along the cord to an extent depending on the force of a drive when the ball is struck (page 3, lines 99-111).

Windall discloses a similar golf practice device wherein two elastic cords 12 and 8 are used. Sections of the cord 8 between stakes 5 and 6 are marked and an indicator 15 is slidably received on cord 8 so that on completion of the shot the player may observe how far the indicator 15 has traveled along the cord and thereby interpolate the forward distance of the drive by noting whether the indicator is at point 16, 17, 18 or 19 which represent one hundred yard marker points (column 2, lines 28-34). It appears to

be the examiner's position that it would have been obvious to place the distance markers on Deane's flexible inelastic cord 5, instead of on a separate tape, to permit the player to observe how far the ball would have theoretically traveled and increase the player's enjoyment of the game (answer, page 3).

We agree with the examiner that Windall provides ample motivation for one of ordinary skill in the art to modify Deane's device to provide the markers right on the cord 5 instead of on a separate tape to achieve the self-evident advantage of simplicity in design, manufacture and assembly. We appreciate appellant's observation that the indicator piece 15 of Windall slides along the cord 8 and markers 16, 17, 18 and 19 are located along the cord 8, not the one attached to the ball, as called for in appellant's claim 6. Be that as it may, from our perspective, one of ordinary skill in the art in possession of the teachings of both Deane and Windall would have taken from Windall a teaching to provide the distance markers directly on the line along which the slidable bead or indicator travels and thus would have been led to provide such markers on the inelastic cord 5 of Deane, which is attached to the golf ball.

As for the recited function of the marks in appellant's claim 6, while appellant has pointed out on pages 3 and 4 of the brief that there is no teaching or suggestion in either Deane or Windall that the indicator or bead and reference markers have or can have any function relating to selection of the crossing point between cord 5 and elastic

material 8, appellant has not explained, and it is not apparent to us, why the bead 11^a and markers on the inelastic cord 5 of Deane would not inherently be capable of performing such function. Accordingly, the functional language of claim 6 does not in this instance serve to patentably distinguish over the graduated markings provided on Deane's cord 5 in view of Windall. See, e.g., In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 230-31 (CCPA 1971) and Ex parte Cordova, 10 USPQ2d 1949, 1950-51 (Bd. Pat. App. & Int. 1987).

Appellant's reliance on In re Gulack, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983) and In re Miller, 418 F.2d 1932, 164 USPQ 46 (CCPA 196), is inapposite. Miller and Gulack establish that, where there is a functional relationship between printed matter recited in a claim and the substrate on which it is located, the printed matter may constitute a structural limitation upon which patentability can be predicated and cannot be ignored in considering the patentability of the claim. In this case, however, the examiner has not ignored the printed matter limitation, that is, the plurality of marks. As discussed above, the combined teachings of Deane and Windall are sufficient to have suggested the provision of markers on the inelastic cord 5 of Deane. Nothing in either Miller or Gulack indicates that the prior art must teach the recited function or purpose of the printed matter at issue in order to render the claimed subject matter unpatentable. Where the structure, in this case the graduated markers on Deane's cord 5, reasonably

appears capable of functioning in the manner called for in the claim, the burden shifts to appellant to prove that the prior art does not possess the characteristic at issue. See In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). In this case, appellant has offered no reason or explanation as to why the markers on Deane's cord 5 would be incapable of indicating a reference point for the elastic material 8 to transverse the inelastic cord 5 in the manner called for in claim 6. Thus, we must sustain the examiner's rejection of claim 6, as well as claims 7-11 which fall therewith.

CONCLUSION

To summarize, the decision of the examiner to reject claims 6-11 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED


IRWIN CHARLES COHEN
Administrative Patent Judge


NEAL E. ABRAMS
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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